

REMARKS

Applicants submit this Amendment in reply to the Office Action dated November 21, 2003. By this Amendment, Applicants amend claims 1, 2, 5, 13, and 15, and add new claims 21-36 to more clearly define the claimed invention. Before entry of this Amendment, claims 1-20 were pending in this application. After entry of this Amendment, claims 1-36 remain pending. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of the amended and newly added claims. No new matter is introduced.

WITHDRAWN CLAIMS

In a Response to Election of Species Requirement filed October 23, 2003, Applicants identified claims 1, 2, 4-6, 12, and 14-16 as reading on the elected subject matter. The Office Action, however, is inconsistent and unclear as to which claims are withdrawn. Page 1 indicates claims 3, 5-11, and 17-20 are withdrawn, page 2 indicates in the first paragraph that claims 3, 4-11, and 17-20 are withdrawn, and the Office Action proceeds with an examination on the merits of claims 1, 2, 4-6, and 12-16. Based on the Examiner's examination of claims on the merits, Applicants understand that only claims 3, 7-11, and 17-20 are withdrawn. This is consistent with Applicants' Response filed on October 23, 2003, along with the Examiner's indication that claim 13 will be examined. Applicants request a clarification of the withdrawn claims if this understanding is incorrect.

Newly added claims 21-36 are drawn to the elected species of FIG. 1.

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INFORMATION DISCLOSURE STATEMENT

In the Office Action, the Examiner did not consider the Information Disclosure Statement and PTO Form 1449 filed on February 14, 2002. As that IDS was properly submitted with copies of the references within the timeframe specified in 37 C.F.R. § 1.97(b), Applicants request consideration of the references documented on the Form PTO 1449 and an indication that they have been considered. With this Amendment, Applicants have submitted a copy of the February 14, 2002 filing. If the Examiner needs an additional copy of any reference, he is invited to contact the undersigned at 202-408-4140.

CLAIM REJECTIONS

In the Office Action of November 21, 2003, the Examiner rejected claims 1, 2, 4-6, and 12-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,308,358 to Bond et al. (Bond et al.). Applicants respectfully traverse these rejections.

INDEPENDENT CLAIM 1

None of the cited references disclose or suggest the invention as claimed in independent claims 1, 13, and 21. For example, independent claim 1, as amended, recites, *inter alia*, a surgical instrument including a flexible tubular member, a handle attached to the proximal end of the flexible tubular member and an end effector assembly for releasably attaching to the distal end of the flexible tubular member. None of the cited references disclose or suggest at least these aspects of the claimed invention either alone or in combination with the other aspects of the claimed invention.

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For example, Bond et al. does not disclose or suggest at least “a flexible tubular member” in combination with the other elements of claim 1. Instead, in all of the disclosed embodiments, Bond et al. teaches the use of only rigid shafts. For example, Bond et al. discloses “a single channel *rigid-shaft* minimally invasive surgical instrument which can be disassembled for improved cleaning and sterilization.” (Col. 4, lines 16-18) (emphasis added). Moreover, Bond et al. expressly teaches away from using its invention with flexible devices. In column 1, lines 34-40, Bond et al. states:

[e]ndoscopic and angioscopic devices typically have flexible assemblies between the handle and the operating end, to allow the operating end to be pointed or twisted in any desired direction as it passes through channels or tunnels inside the body. Any such devices which have flexible shafts are not covered by the subject invention.

Accordingly, Bond et al. teaches away from a surgical instrument as recited in independent claim 1 that includes “a flexible tubular member.” For at least these reasons, Applicants respectfully request that the rejection of independent claim 1 and its dependent claims 2, 4-6, and 12 be withdrawn.

INDEPENDENT CLAIM 13

Claim 13 recites an end effector assembly for an endoscopic surgical instrument having a flexible elongate tubular member including, among other things, “an end effector; and an attachment portion connected to the end effector and configured to attach releasably to the flexible tubular member.”

By the amendment to claim 13, Applicants intend the preamble to limit the invention of that claim, as well as the body of the claim, to an end effector assembly of

an endoscopic instrument having a flexible elongate tubular member. Accordingly, the teachings of the prior art against which patentability is measured are end effectors suitable for use in combination with a flexible elongate tubular member of an endoscopic instrument.

For the same reasons presented above with respect to independent claim 1, Bond et al. teaches away from an end effector assembly for an endoscopic surgical instrument having a "a flexible elongate tubular member." For at least these reasons, the rejection of independent claim 13 and its dependent claims 14-16 should be withdrawn.

NEW CLAIMS 21-36

By this Amendment, Applicants have added new claims 21-36 drawn to the elected species. None of the cited prior art, alone or in combination, teaches or suggests the surgical instrument recited in claims 21-36. Applicants request examination and favorable consideration of the newly submitted claims.

CONCLUSION

In view of the foregoing remarks, this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action. In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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